

### REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on September 14, 2009. A petition for a one month extension of time is submitted with the Amendment. The Commissioner is hereby authorized to charge \$130.00 for the petition for extension of time and any additional fees that may be required or credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 3712036-568 on the account statement.

Claims 1-5, 8 and 10-20 are pending in this application. Claims 6-7 and 9 were previously canceled without prejudice or disclaimer. In the Office Action, Claims 1-5, 8 and 10-20 are rejected under 35 U.S.C. §112; Claims 1-5, 8, 10-16 and 18-20 are rejected under 35 U.S.C. §102(b); and Claims 1-5, 8 and 10-20 are rejected under 35 U.S.C. §103(a). In response, Claims 1 and 20 have been amended. The amendments do not add new matter. In view of the amendments and/or for at least the reasons set forth below, Applicants respectfully request that the rejections be reconsidered and withdrawn.

Applicants have amended independent Claims 1 and 20 to address some informalities.

In the Office Action, Claims 1-5, 8 and 10-20 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Patent Office alleges that the phrase "the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%" in Claims 1 and 20 is unclear. Applicants respectfully disagree and submit that the phrase is clear to the skilled artisan in view of the specification.

Consistent with the well-established axiom in patent law that a patentee or applicant is free to be his or her own lexicographer, a patentee or applicant may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings if the written description clearly redefines the terms. See, e.g., *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) ("While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning," in such a situation the written description must clearly redefine a claim term "so as to put a reasonable competitor or one reasonably skilled in the art on notice that the

patentee intended to so redefine that claim term."); *Hormone Research Foundation Inc. v. Genentech Inc.*, 904 F.2d 1558, 15 USPQ2d 1039 (Fed. Cir. 1990).

Applicants have clearly defined the term "water absorbency rate" as being measured with a package being emptied from the water-soluble material. The water absorbency rate thereby corresponds to the formula  $(X2 \cdot 100) / X1$ , wherein X2 is the weight of the final package after being soaked in hot water during 30 seconds and X1 being the weight of the same dry package. See specification, page 5, lines 6-15. In other words, the water absorbency rate measures the amount of liquid that is absorbed by the wetted final package as compared to the initial package when dry. As a result, the skilled artisan can define the metes and bounds of the claims in view of the clear teaching of the specification.

Based on at least these noted reasons, Applicants believe that Claims 1-5, 8 and 10-20 fully comply with 35 U.S.C. §112, second paragraph. Accordingly, Applicants respectfully request that the rejection of Claims 1-5, 8 and 10-20 under 35 U.S.C. §112 be withdrawn.

In the Office Action, Claims 1-5, 8, 10-16 and 18-20 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,554,400 to Stipp ("*Stipp*"). Applicants respectfully traverse the rejection for at least the reasons set forth below.

Independent Claims 1 and 20 recite, in part, a beverage portioned package containing a water-soluble beverage material in an amount sufficient to form the beverage and a filler. The filler comprises a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material. The filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%. In contrast, *Stipp* fails to disclose or suggest each and every element of independent Claims 1 and 20.

The water-soluble beverage material of the claimed invention provides the primary beverage ingredient for the beverage which is delivered through an extraction device. See specification, page 6, lines 30-33. The portion of water-soluble beverage material is intended to thoroughly mix with water during the extraction. See specification, page 7, lines 1-2. The water-soluble beverage material includes, for example, soluble coffee powder, milk powder,

creamer powder, cocoa powder and mixtures thereof. See specification, page 7, lines 6-7. The filler maintains a sufficient pressure of extraction while the water-soluble beverage material dissolves in the water passing through the package to release the beverage. See specification, page 2, lines 25-28. The filler is configured to decrease the pressure drop during extraction to less than 0.2 bars. See specification, page 3, lines 3-6. Maintaining the pressure during extraction ensures that the beverage delivers the desired solids concentration and that a sufficient amount of foam is created. See specification, page 2, lines 29-31. A beverage package including such filler thus provides significantly improved properties over beverage packages that do not contain such a filler. See specification, page 2, lines 31-32.

*Stipp* fails to disclose or suggest that the filler comprises a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material as required by independent Claims 1 and 20. *Stipp* also fails to disclose or suggest that the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200% as required by independent Claims 1 and 20. Instead, *Stipp* is entirely directed toward an infusion product for making a beverage, the product having an infusible material and a soluble additive material packaged in an infusion bag. The soluble additive material comprises a co-agglomerate of a creamer base and a sweetener base. See *Stipp*, Abstract.

In the Office Action, the Patent Office refers to column 9, lines 32-37 of *Stipp* where it is mentioned that the bag is sized to permit movement of the infusion material and the soluble particles. Specifically, *Stipp* discloses that “[t]he bag must be sized to permit movement of the infusion material and soluble additive material particles therein. That is, the material particles must not be so tightly packed in the bag as to restrict free contact between the water and the particles throughout the bag in the preparation of a beverage.” See *Stipp*, column 9, lines 32-36 (emphasis added). Thus, it must follow that *Stipp* is entirely directed toward avoiding compaction of the particles together and, therefore, there cannot be pressure maintained by the infusion material during extraction. Instead, the bag of *Stipp* is more akin to a tea bag in which materials are loosely placed. When water begins to flow in and dissolves the water soluble

coffee, there is even more free place inside and the pressure is not at all maintained. Indeed, *Stipp* even discloses that the bag is “submerged” and “dunk[ed]” in water, as is typical with tea bags.

As such, *Stipp* cannot disclose a package that comprises water-soluble filler that maintains extraction pressure of the beverage during dissolution of the water-soluble beverage material above a certain pressure. Further, *Stipp* fails to disclose a filler that has certain water-absorbent properties, let alone properties that provide a water absorbency rate of a package of at least 200% in accordance with the present claims.

Applicants also submit that it would not be inherent that the filler of *Stipp* would inherently disclose a filler having water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%. To satisfy the test for inherency, the Patent Office would be required to show that the fillers of *Stipp* necessarily (*i.e.*, always or automatically) provide for a filler having water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%. That condition simply is not met under the present circumstances. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See, MPEP 2112. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993).

For at least the reasons discussed above, *Stipp* fails to disclose or suggest each and every element of independent Claims 1 and 20, along with the claims that depend from Claims 1 and 20. Accordingly, Applicants respectfully request that the rejection of Claims 1-5, 8, 10-16 and 18-20 under 35 U.S.C. §102(b) be reconsidered and withdrawn.

In the Office Action, Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,554,400 to Stipp (“*Stipp*”). Applicants respectfully submit that the patentability of independent Claim 1 as previously discussed renders moot the obviousness rejection of Claim 17 that depends from Claim 1. In this regard, the cited art fails to teach or suggest the elements of Claim 17 in combination with the novel elements of Claim 1. For at least the reasons discussed above, Applicants respectfully submit that Claim 17 is novel, nonobvious and distinguishable from the cited reference.

Accordingly, Applicants respectfully request that the rejection of Claim 17 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

In the Office Action, Claims 1-4, 8 and 10-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0096038 to Cai ("*Cai I*") in view of EP 1142483 to Groen ("*Groen*"). Claims 1-3, 5 and 10-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Cai II* in view of U.S. Patent No. 3,833,740 to Schmidt ("*Schmidt*"). Claims 1-5, 8 and 10-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,110,732 to Kane ("*Kane*") in view of U.S. Patent No. 6,777,007 to Cai ("*Cai II*"). In contrast, Applicants respectfully traverse the rejections for at least the reasons set forth below.

*Kane*, *Cai I*, *Cai II*, *Schmidt* and *Groen* alone or in combination fail to disclose or suggest that the filler comprises a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material as required by independent Claims 1 and 20. *Kane*, *Cai I*, *Cai II*, *Schmidt* and *Groen* alone or in combination also fail to disclose or suggest that the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200% as required by independent Claims 1 and 20.

*Kane* is entirely directed toward coffee balls that comprise a relatively small bag or sack made of gauze or open-mesh fabric that contains a charge of dry, soluble coffee product and a requisite amount of coarsely crushed, roasted coffee having a grain size larger than the meshes of the gauze or fabric. See *Kane*, column 2, lines 37-42. Thus, the water in *Kane* flows into the coffee ball through all of the surfaces of the coffee ball and the beverage flows out through all of the surfaces of the coffee ball as well. This is in direct contrast to the present invention wherein the package includes a first surface for flowing water in the package and a second, different, surface for flowing the beverage out.

Further, *Kane* deals exclusively with the problem of improving the taste of a coffee beverage produced from soluble coffee by adding fresh coffee particles to the soluble coffee. At no point in the disclosure does *Kane* even disclose or suggest that the water is introduced into the package under pressure. Indeed, the coffee balls of *Kane* are also akin to tea bags and *Kane* explicitly discloses that it is preferred to "place the ball in the bottom of a cup and pour boiling water having a [certain temperature] over the same." See *Kane*, page 2, column 2, lines 11-14.

Accordingly, the coffee balls of *Kane* are entirely distinguishable from the packages of the present invention. *Kane* fails to disclose or suggest a filler comprising a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material or that the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200% in accordance with the present claims.

*Cai I* and *Cai II* disclose pods or cartridges for making coffee wherein the flavor-containing material is sandwiched between porous sheets or barriers. However, at no place in the disclosure do *Cai I* and *Cai II* disclose or even suggest that a filler maintains extraction pressure of the beverage during dissolution of the water-soluble beverage material above a certain pressure. *Cai I* and *Cai II* also fail to disclose or even suggest that the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%. In fact, *Cai II* would teach the skilled artisan that, if insoluble coffee particles and soluble coffee were mixed in a pod to improve the taste of the soluble coffee in the pods, these two materials should be placed in two separate layers as is disclosed in *Cai II* at column 9, line 42-column 10, line 9.

*Schmidt* discloses a coffee pack designed to be put in a cup of water. *Groen* discloses a package containing roasted, ground coffee and at least one absorbent for coffee oil suitable for filter paperless coffee machines. See *Groen*, paragraph 5. *Groen* provides no description of the package other than reciting these two components. Moreover, *Schmidt* and *Groen* fail to teach any filler having water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200% in accordance with the present claims.

For at least the reasons discussed above, Applicants respectfully submit that Claims 1-5, 8 and 10-20 are novel, nonobvious and distinguishable from the cited references. Accordingly, Applicants respectfully request that the rejections of Claims 1-5, 8 and 10-20 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

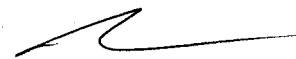
For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there

remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

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